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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/806,281

03/23/2004

Shany Elkarat

27300

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7590

08/11/2006

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EXAMINER

ZEWDU, MELESS NMN

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicant(s) 10/806,281	Applicant(s) ELKARAT ET AL.	
	Examiner Meless N. Zewdu	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,11,13,16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,11,13,16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the communication filed on 6/12/02.
2. Claims 9, 10, 12, 14, 15 and 19-39 were cancelled in a previous amendment. Claims 1-8, 11, 13, 16 and 17 are pending in this action.
3. Taking applicant's argument into consideration, examiner has removed Jiang's reference from further consideration.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this regard the feature, "wherein the output signal is a failure to reply to a roaming request in a given time" is indefinite because, a failure to reply, in this context, doesn't need an output signal to fail to reply.

Claims 1 and 11 recites the limitation "said detection probe" in line 5 of both claims 1 and 11. There is insufficient antecedent basis for this limitation in the claim. These claims can be improved by changing the "probe" to "unit", as provided in the preamble.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hronek (US 6,564,055 B1) in view of Byrne (EP 0 719 064 A2).

As per claim 1: Hronek discloses a remote preference unit influencing visited network selection by roaming units (see abstract, particularly, lines 1-21), the preference unit comprising:

a detection unit for detection of roaming activity by mobile units (see abstract, particularly, lines 16-24; col. 5, lines 18-34). When a mobile enters a new geographic area (visited area/network), a detectable triggering event is generated in the network.

a database indicative of preference networks for selection by roaming units, and an output unit, associated with said detection probe and said database to output indications to influence network selection by said detected roaming unit (see abstract, particularly lines 1-24; col. 3, lines 40-61). But, Hronek does not explicitly teach about outputting roaming rejection signals to roaming request attempts to respective non-preferred roaming networks, and sending said roaming rejection signals to location infrastructure of respective non-preferred networks, thereby to cause roaming request attempt to fail at said non-preferred network and force said mobile units to re-attempt

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roaming requests to select a preferred roaming network, as claimed by applicant.

However, in the same field of endeavor, Byrne teaches about a radiotelephone hands over system wherein, if a CCT (cordless cellular telephone) having a call in progress on a non-preferred system enters the service area of a preferred system, then the CCT can register with the preferred system, and flag the system MSC or network control center that it is a preferred system, following which the preferred system MSC or network control center can communicate with the non-preferred system's MSC or network control center and instruct it to handover the call to the preferred system (see col. 9, lines 36-46). Note: the preferred system/network communicating with the non-preferred system/network to cause the non-preferred system to handover the cellular telephone to the preferred system. is functionally similar, but more advantageous than the rejection called by the claimed feature.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the teaching of Hronek with that of Byrne for the advantage, that a call may be automatically carried out using a radiotelephone system having the highest signal quality or lowest cost (see col. 4, lines 13-18).

As per claim 2: Hronek discloses a remote preference unit, further comprising logic for assigning different preference information under different conditions (see col. 6, lines 60-64). New location, selecting of particular subscription plan and time of day are different conditions.

As per claim 3: Hronek discloses a remote preference unit, wherein said conditions comprise time, such that different network selection preferences are sent out based on

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different times (see col. 6, lines 60-64). Hronek provides different network selection preferences, which can be downloaded to individual mobiles based on time of day.

As per claim 4: Hronek teaches a remote unit (IRDB), wherein a time used to set said preferences is local time at a roaming location (see col. 6, lines 60-64). According to the prior art, time of day is dependant upon current location of a roaming mobile, hence, local.

As per claim 5: Hronek discloses a remote preference unit, wherein said conditions comprise one of profile settings and abilities of an individual roaming handset (see col. 3, lines 45-60). Examiner considers ability as ability of the handset to receive/download preferred roaming list from a remote database and roam using the same.

As per claim 6: Hronek discloses a remote preference unit, wherein said conditions are based on a segment/group of users to which a current handset belongs, such that said preference information is applied to differently to different segments (see col. 5, lines 13-2). The prior art discloses that only handsets located in a relevant geographic region are updated.

As per claim 7: Hronek discloses a preference unit, wherein said conditions comprise the proportions of roaming users currently connected to different available networks in a give roaming region (see col. 5, lines 58-67).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied to claim 1 above, and further in view of examiners Official Notice.

As per claim 8: Hronek does not explicitly teach about a remote preference unit, wherein said output signal is a failure to reply to a roaming request in a given time, thereby inducing a time-out to said request, as claimed by applicant. As discussed above, a failure to reply could not be an output signal. The claimed feature is interpreted as, simply, failure to reply ----. Examiner believes that it is well known that not replying/responding to an action that is a function of time will cause the time to expire for the intended action. Since, roaming involves time (function of time), it requires a timely action/response, the lack of which will cause the time to expire for the intended action. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to let a reply time to a roaming request expire, since it is well known to not to respond or reply to a timing control action by letting the time for response/action expire.

Claims 11, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hronek in view of La Medica, Jr. et al. (La Medica) (US 6,625,451 B1) and Martschitsch (US 2002/0193127 A1).

As per claim 11: some of the features of claim 11 are similar to the features of claim 1 disclosed by Hronek, and thus, are rejected on the same ground, as claim 1.

Regarding the difference features, La Medica, in the same field of endeavor, teaches:

an up-to-date version of at least a part of said database for downloading to said detected mobile units (see abstract, fig.3; col. 15, lines 9-19; col. 16, lines 5-23), at least said mobile units thereby being able to consult said up to date version for network selection (see col. 16, lines 56-64), a connection to a SIM card infrastructure through

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which to download said up-to-date version to said units (see col. 13, lines 30-45; col. 15, lines 40-52). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made modify the teaching of Hronek with that of La Medica for the advantage of periodically downloading new updated version of PRL list for mobile subscribers as the service provider's business arrangement changes over time (see col. 16, lines 8-12). But Hronek in view of La Medica does not explicitly teach about downloading an applet to said mobile units to govern use of said up to date version, said applet containing dialing services customized for a current roaming region, as claimed by applicant. However, in a related field of endeavor, Martschitsch teaches about method and system for preparing and transmitting SMS messages in a mobile radio tower, wherein a JAVA applet program is downloaded into an identification module (SIM) over an air interface (see paragraph 0035), wherein the downloaded program enables a user select a phone number from a call number directory (see paragraph 0036). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the above references with the teaching of Martschisch for the advantage of enabling a radio network prepare and transmit an SMS to mobile users (see paragraph 0002).

As per claim 13: Hronek teaches a preference unit, wherein said connection is operable to download said up to date version using SMS (see col. 11, lines 15-22).

As per claim 17: Hronek discloses a remote preference unit, wherein said output unit further comprises an association with said probe for rejecting a roaming request from a

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respective non-preferred roaming network, in association with said download of said up to date version (see col. 2, lines 4756).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 11 above, and further in view of Weiner (US 2004/0204117 A1).

As per claim 16: the above references do not explicitly teach about a preference unit, wherein said dialing services customized for a current roaming region are any of a group comprising intelligent call completion, home short code, world wide number, and iVPN, as claimed by applicant. However, in a related field of endeavor, Weiner teaches about roamers' friendly phone book method and device, wherein a roaming handset is provided with dialing services that include, among others, a list of short codes (see paragraphs 0034; 0055-0058). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to further modify the above references with the teaching of Weiner for the advantage of providing users with a user friendly phone book (see title).

Response to Arguments

Applicant's arguments with respect to claims 1-8, 11, 13 16 and 17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Meless N. Zewdu whose telephone number is (571) 272-7873. The examiner can normally be reached on 8:30 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corsaro Nick can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A ny inquiry of a general nature relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

Meless zewdu

Zewdu, Meless 7-27-06

Examiner

27 July 2006.